REMARKS

This is a timely reply to the Final Office Action of September 25, 2002 with a petition and fee for a three month extension of time. In that Final Office Action, the Examiner rejects all pending claims of the application. These rejections are traversed below.

Claims 1 and 7 – 9 rejected under 35 U.S.C. 112, first paragraph

In section 1 of the Office Action, the Examiner rejects Claims 1 and 7 – 9 under 35 U.S.C. 112, first paragraph. Specifically, the Examiner asserts that the "table-producing unit" is critical or essential to the practice of the invention. However, the Examiner has not cited any specific portion in the specification that sets forth that the "table-producing unit" is critical or essential to the practice of the invention as claimed in Claim 1 and 7 - 9. Therefore, the Applicants submit that Claims 1 and 7 – 9 are not indefinite for the failure to recite a "table-producing unit" as an element of the claimed invention. The Applicants respectfully request that the Examiner withdraw the rejection of Claims 1 and 7 – 9 under 35 U.S.C. 112, first paragraph.

Claims 40 and 43 rejected under 35 U.S.C. 112, first paragraph

In section 2 of the Office Action, the Examiner rejects Claims 40 and 43 under 35 U.S.C. 112, first paragraph. Specifically, the Examiner asserts that "menu" data as recited in the claims is not supported in the specification. However, The Applicants submit that "menu" data is supported in the specification, as originally filed, at least at page 11, line 26 to page 12, line 1. Therefore, the Applicants submit that the subject matter recited in Claims 40 and 43 is supported in the specification and respectfully request that the rejection of Claims 40 and 43 under 35 U.S.C. 112, first paragraph, be withdrawn.

Claims 1- 3, 19 and 21 rejected under 35 U.S.C. 103 based on Heo and Yonemitsu

In section 4 of the Office Action, the Examiner rejects Claims 1-3, 19 and 21 under 35 U.S.C. 103(a) as being unpatentable over Heo considered with Yonemitsu et al. However, the Examiner is reminded that to establish a *prima facie* case of obviousness, the Examiner must show: (1) that

there is some suggestion or motivation to modify the reference or to combine reference teachings; (2) that there is a reasonable expectation of success; and (3) that the prior art reference or references teach or suggest each and every claim limitation. See MPEP 2142. Further, the suggestion or motivation to modify or combine and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. The Applicants submit that the Examiner has neither adequately shown a motivation to combine the references in the manner done by the Examiner nor has the Examiner shown that the asserted combination teaches each and every element of the rejected claims. Therefore, the Applicants submit that the Examiner has not established a *prima facie* case of obviousness based on the cited prior art, and the claims are patentable over these cited references.

Specifically, the Examiner asserts that motivation to modify Heo with the teachings of Yonemitsu is "to provide for such routine information along with other management information in the TOC area." However, where is the motivation in either Heo or Yonemitsu to provide for "routine" information? If the information is "routine," would it not already be in the disclosure of Heo? The Applicant submits that the only suggestion for "start address, playback time and attributes of the unit audio information" as recited in independent Claims 1 and 7 is provided by the Applicants' own disclosure. The Applicants submit that the Examiner has improperly relied upon the Applicant's own disclosure and, therefore, has not established a *prima facie* case of obviousness based on the cited references.

Further, the Applicants submit that the Examiner has not shown that the combination of references teach "attributes of the unit audio information." The Examiner has not shown how or where either Heo, Yonemitsu, or the combination of these references teach this element. The Applicants submit that the Examiner has not shown how the combination of references teaches each and every element of Claims 1 and 7 - 9, and, therefore has not established a *prima facie* case of obviousness based on the cited references.

Claims 1- 3 and 4 - 6 rejected under 35 U.S.C. 103 based on Moriyama and Yonemitsu

In section 5 of the Office Action, the Examiner rejects Claims 1-3 and 4 - 6 under 35 U.S.C. 103(a) as being unpatentable over Moriyama considered with Yonemitsu et al. The Applicants submit that the Examiner has not adequately shown a motivation to combine the references in the manner done by the Examiner. Therefore, the Applicants submit that the Examiner has not established a *prima facie* case of obviousness based on the cited prior art, and the claims are patentable over these cited references.

Specifically, the Examiner asserts that motivation to modify Moriyama with the teachings of Yonemitsu is "to provide such management information to the user for its inherent function." However, where is the motivation in either Heo or Yonemitsu to provide for such management information? If the information is inherent, would it not already be in the disclosure of Moriyama? The Applicant submits that the only suggestion for " playback time and attributes of the unit audio information" as recited in independent Claims 1 and 4 is provided by the Applicants' own disclosure. The Applicants submit that the Examiner has improperly relied upon the Applicant's own disclosure and, therefore, has not established a *prima facie* case of obviousness based on the cited references.

Claims 4 – 15 rejected under 35 U.S.C. 103 based on Heo and Yonemitsu and Yamamoto or Yoshio

In section 6 of the office Action, the Examiner rejects Claims 4 – 15 under 35 U.S.C. 103(a) as being unpatentable over Heo and Yonemitsu and further in view of Yamamoto or Yoshio. The Applicants submit that Claims 4 – 15 are patentable over the cited references for at least the same reasons set forth above for the patentability of Claims 1 – 3, 19 and 21.

Claims 4 – 15 rejected under 35 U.S.C. 102(e) or under 35 U.S.C. 103(a) based on Moriyama and Yonemitsu and Yamamoto or Yoshio

In section 7, the Examiner rejects Claims 4 – 15 under 35 U.S.C. 102(e) as being anticipated by, or in the alternative, under 35 U.S.C. 103(a) as being made obvious by Moriyama and Yonemitsu further consider with either Yamamoto or Yoshio. For the rejection based on 103, the Applicant submit that Claims 4 – 15 are patentable over the cited references for at least the same reasons set forth above for the patentability of Claims 1 – 3 and 4 – 6. For the alleged 102(e) rejection, the Applicant notes that the Examiner appears to agree that Moriyama does not teach, at least, the feature related to playing time. Therefore, it appears that the Examiner agrees that Moriyama does not teach each and every element as set forth in Claims 4 – 15 and, therefore, a rejection under 102(e) is improper.

Claims 22 - 29 rejected under 35 U.S.C. 103 based on Moriyama and Yonemitsu and Yamamoto or Yoshio

In section 8 of the Office Action, the Examiner rejects Claims 22 - 29 under 35 U.S.C. 103(a) as being unpatentable over Moriyama and Yonemitsu further considered with either Yamamoto or Yoshio. The Applicant submit that Claims 22 - 29 are patentable over the cited references for at least the same reasons set forth above for the patentability of Claims 1 – 3 and 4 – 6.

Claims 30 - 37 rejected under 35 U.S.C. 103 based on Moriyama and Yonemitsu and Heo

In section 9 of the Office Action, the Examiner rejects Claims 30 - 37 under 35 U.S.C. 103(a) as being unpatentable over Moriyama and Yonemitsu further considered with either Heo. The Applicant submit that Claims 30 - 37 are patentable over the cited references for at least the same reasons set forth above for the patentability of Claims 1 – 3 and 4 – 6.

Claims 38 – 39, 41 and 42 rejected under 35 U.S.C. 103 based on Moriyama and Yonemitsu and Heo

In section 6 (sic, page 5) of the Office Action, the Examiner rejects Claims 38-39, 40 and 41 under 35 U.S.C. 103(a) as being unpatentable over Yonemitsu considered with Moriyama. The Applicant submit that Claims 38 – 39, 41 and 42 are patentable over the cited references for at least the same reasons set forth above for the patentability of Claims 1 – 3 and 4 – 6.

Conclusion

Hence, the Applicants respectfully submit that all pending claims are patentable over the cited references. In view of the above, reconsideration and allowance of the pending claims are respectfully solicited. However, to ensure the continued prosecution of this application if the Examiner should find the arguments presented above to be unpersuasive, an RCE is also being filed.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to: Box AF, Commissioner for Patents, Washington, D.C., 20231 on

March 21, 2003
(Date of Deposit)

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Respectfully submitted,

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